

REMARKS:

The undersigned has been appointed by the Applicant to continue prosecution of the subject application. A Revocation of Power of Attorney and New Power of Attorney is being filed herewith.

Claim 1 has previously been cancelled and claims 2-91 and 97-111 have previously been withdrawn.

Claims 92-96 are presented for further consideration by the Examiner.

Reconsideration and withdrawal of the outstanding rejections is respectfully requested in light of the following remarks.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 92-96 stand rejected under 35 U.S.C. § 103(a) over Pallakoff (U.S. Patent No. 6,269,343) in view of Tuttrup (U.S. Patent Application Publication No. 2002/0038266).

This rejection is respectfully traversed.

First, it should be noted that there are at least several aspects of the present invention for which Pallakoff and Tuttrup are not properly citable as "prior art" under 35 U.S.C. § 102. For at least the reasons stated below, Pallakoff and Tuttrup cannot be properly relied upon for disclosing or suggesting all of the limitations of claims 92-96.

The present Application is a Continuation-In-Part of U.S. Patent Application No. 09/968,962 filed 2 October 2001 ('962 Application). The '962 Application claims priority to U.S. Provisional Patent Application No. 60/237,157 filed 2 October 2000 ('157 Application). The '962 Application is also a Continuation-In-Part of U.S. Patent Application No. 09/619,947 filed 20 July 2000 ('947 Application). The '947 Application claims priority to U.S. Provisional Patent Application No. 60/144,682 filed 20 July 1999 ('682 Application) and also claims priority to U.S. Provisional Patent Application No. 60/149,011 filed 13 August 1999 ('011 Application).

With respect to Pallakoff, this reference was filed on 18 August 1999 and issued on 31 July 2001. Because claims 92-96 are considered to be fully supported by at least the '157 Application and the '947 Application, and because the '157 Application and the '947 Application were both filed before Pallakoff issued, Pallakoff cannot be cited under 35 U.S.C. § 102(a). Pallakoff also cannot be cited under § 102(b) because Pallakoff did not issue more than one year prior to the filing of the present Application.

Finally, Pallakoff cannot be relied upon under 35 U.S.C. 102(e) for at least the limitations of claims 92-96 that are supported by the '011 Application and the '682 Application since the '011 and '682 Applications were filed before the 18 August 1999 filing date of Pallakoff. For example, Applicants consider "identifying a product utilizing said distributed data processing system," "soliciting purchase commitments from potential purchasers over said distributed data processing system," and "accepting contingent offers which depend upon obtaining a predetermined minimum number of offers before acceptance of said offers" to be fully supported by one or both of the '011 and '682 Applications.

It is noted that Pallakoff claims priority to two earlier filed Provisional Applications. If the Examiner intends to rely on the filing date of one or both of these Provisional Applications in order to establish an earlier 102(e) filing date, then it is respectfully requested that the Examiner provide a showing of how the Provisional Application(s) properly supports the subject matter relied upon to make the rejection in compliance with the first paragraph of 35 U.S.C. § 112.

With respect to Tuttrup, this reference was filed on 16 May 2001 and issued on 28 March 2002. Tuttrup cannot be cited under § 102(a) because Tuttrup did not issue prior to the filing of the present Application. Also, Tuttrup cannot be cited under § 102(b) because Tuttrup did not issue more than one year prior to the filing of the present Application.

Finally, because claims 92-96 are considered to be fully supported by at least the '157 Application and the '947 Application, and because the '157 Application and the '947

Application were both filed before the filing date of Tuttrup, Tuttrup cannot be cited under 35 U.S.C. § 102(e).

It is noted that Tuttrup claims priority to an earlier filed Provisional Application. If the Examiner intends to rely on the filing date of the Provisional Application in order to establish an earlier 102(e) filing date, then it is respectfully requested that the Examiner provide a showing of how the Provisional Application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. However, even if the Examiner intends to rely on the filing date of the Tuttrup Provisional Application, Tuttrup still would not be properly citable under 35 U.S.C. 102(e) for at least the limitations of claims 92-96 that are supported by the '011 Application and the '682 Application since the '011 and '682 Applications were filed before 7 July 2000 filing date of the Tuttrup Provisional Application.

Even if Pallakoff and Tuttrup were properly citable against all of the limitations of claims 92-96, the proposed combination of Pallakoff and Tuttrup would still fail to disclose or suggest all of the limitations of claims 92-96.

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Claim 92 recites *inter alia* "utilizing at least one visual representation of shipping space available within a standardized shipping volume...to communicate over time whether or not sufficient financial commitments have been obtained...to fill one or more standard shipping containers."

In this case, the cited references clearly do not "disclose each and every element of the claimed invention." This fact is even conceded in the present Office Action, which concedes that Pallakoff and Tuttrup "fail to teach that an indicator such as a visual

representation of the level of fulfillment of a shipping container is utilized.” Office Action, page 4, lines 3-5. Thus, Pallakoff, Tuttrup, and the proposed combination thereof all fail to render claim 92 and its dependent claims obvious.

The Office Action further includes an allegation that “[i]t was old and well known in the art at the time of the invention to use visual indicators to show current status.” Office Action, page 4, lines 5-6. This allegation is respectfully traversed. The Office Action cites no references or other evidence to support this allegation. Further, the Office Action includes no explicit statement indicating that Official Notice is taken.

If this allegation is intended to be based on Official Notice, then Applicant hereby traverses the Official Notice because the asserted facts are not supported by documentary evidence and appear to be the Examiner’s opinions formulated using the present application as a template, which constitutes impermissible use of hindsight.

“Official Notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While ‘official notice’ may be relied upon, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy the dispute’(citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961)).” MPEP § 2144.03(A) (emphasis in original).

“It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03(A) (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. Thus, if the Examiner continues to maintain the rejection of claims 92-96 based on the Official Notice, the Applicant requests that the Examiner provide documentary evidence as stated in Section 2144.03 of the M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See MPEP § 2144.03(C)).

Furthermore, assuming solely for the sake of argument (but not conceding this point) that “visual indicators to show status” were known at the time of the invention, such teaching would be grossly insufficient for rendering obvious “visual representation of shipping space available within a standardized shipping volume... to communicate...whether or not sufficient financial commitments have been obtained...to fill one or more standard shipping containers.” A teaching of simply providing an indicator of status would fail to necessarily or inherently disclose or suggest anything having to do with visually representing available shipping space and whether sufficient commitments have been obtained to fill one or more shipping containers.

Further with respect to Tuttrup, it is noted that this reference discloses a fulfillment system that combines goods ordered by a plurality of customers into a single shipping order. However, Tuttrup is silent with respect to the capacity of shipping containers, as is Pallakoff as conceded in the Office Action (See page 3, lines 13 and 14). Thus, the proposed combination of Pallakoff, Tuttrup, and the alleged knowledge in the art regarding visual representation of status would fail to teach “visual representation of shipping space available within a standardized shipping volume... to communicate...whether or not sufficient financial commitments have been obtained...to fill one or more standard shipping containers” as recited in claim 92.

In light of the above remarks, it is respectfully submitted that claims 92-96 are in condition for allowance, and notice to that effect is respectfully requested.

The Legal Standard for Obviousness Rejections Under 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

Enclosed is a Request for Three-Month Extension of Time and our check in the amount of \$510.00 to cover the fee for the three-month extension of time. No additional fees are deemed to be necessary; however, the undersigned hereby authorizes the Director to charge any additional fees that are necessary, or credit any overpayments, to Deposit Account No. **502806**.

Please link this application to Customer Nos. 50779 and 38441 so that its status may be checked via the PAIR System.

Respectfully submitted,

25 JULY 2005

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